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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chan U. Ko	AVERP2997USA	4665
7590	04/14/2004		EXAMINER	
William C. Tritt Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 04/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 10/028,867	<b>Applicant(s)</b> KO ET AL.	
	<b>Examiner</b> Victor S Chang	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 4/5/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, the rejections of sections 5-8 of prior Office action mailed 2/23/2004 are withdrawn for now, and the finality of that action is also withdrawn for now, and to be reinstated in the next Office action upon Applicants' election of restricted groups and species as follows.

***Election/Restrictions***

4. Applicants' continued argument that "Claims 26, 27 and 30-36 are not directed to an invention distinct from and independent of the invention previously claimed" (Remarks, page 7, fourth paragraph) has been carefully considered. The Examiner notes that claims 26, 30 and 32-36 are clearly new species not presented in the original claims. Further, in response to Applicants' argument, the Examiner now notes that election/restriction requirement becomes necessary as follows, so as to clarify the subject matter of claimed invention, and move the prosecution forward.
5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, 35 and 36, drawn to a vinyl halide film, classified in class 428, subclass 95.

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- II. Claims 15-21, drawn to an adhesive article comprising a vinyl halide film and a pressure sensitive adhesive, classified in class 428, subclass 343.
- III. Claims 22-24, drawn to a plastisol, classified in class 521, subclass 73.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as packaging film and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Inventions Group III and Group I, and Group III and Group II, are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph),

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and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as sealant and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. This application also contains claims directed to the following patentably distinct species of the claimed invention:

I. Vinyl halide polymer

Species 1: homopolymer of vinyl chloride (see claims 2, 16 and 23).

Species 2: copolymer of vinyl halide (see claims 2, 16).

II. Non-halogenated polymeric plasticizer

Species 3: natural rubber (see claims 4, 18).

Species 4: synthetic rubber (see claims 4, 18).

Species 5: polybutadiene rubber (see claims 5, 19).

Species 6: polyisoprene rubber (see claims 5, 19).

Species 7: styrene-butadiene rubber (see claims 5, 19).

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Species 8: styrene-isoprene rubber (see claims 5, 19).

Species 9: nitrile rubber (see claims 5, 6, 11, 19, 20).

Species 10: butyl rubber (see claims 5, 19).

Species 11: ethylene-propylene terpolymer (see claims 5, 19).

Species 12: silicone rubber (see claims 5, 19).

Species 13: polyacrylate rubber (see claims 5, 19).

Species 14: epichlorohydrin rubber (see claims 5, 19).

Species 15: fluoroelastomer (see claims 5, 19).

Species 16: polyurethane (see claims 5, 19).

Species 17: ethylene-alpha-olefin rubber (see claim 26).

Species 18: block copolymer of a vinyl aromatic and conjugated diene (see claim 26).

Species 19: block copolymer of a vinyl aromatic and functionalized conjugated diene derivative (see claim 26).

Species 20: block copolymer of polyalkylene terephthalate and polyalkylene ether (see claim 26).

Species 21: polyether block polyamide elastomer (see claim 26).

Species 22: polyester block polyamide elastomer (see claim 26).

Species 23: one of the numerous copolymers or terpolymers listed in claim 26, not have been listed above (see claim 26, 27).

Species 24: one of the numerous species listed in claims 30 and 31, not have been listed above (see claims 30 and 31).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1, 3, 7-10, 12-15, 17, 21, 22, 24, 25, 28 and 29 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at

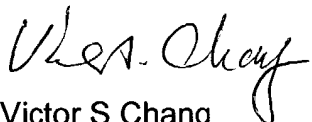
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least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

4/12/2004